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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,808	10/11/2005	Bernhard Gleich	DE 030124	5527

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BRIARCLIFF MANOR, NY 10510

EXAMINER

GUPTA, VANI

ART UNIT	PAPER NUMBER
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3768

MAIL DATE	DELIVERY MODE
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04/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,808	Applicant(s) GLEICH, BERNHARD	
	Examiner VANI GUPTA	Art Unit 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 – 14 and, drawn to apparatus and use of apparatus for examination and use of an electrical field in a magnetic gradient field, containing magnetic particles in examination area.

Group II, claim(s) 15, 16, and 22 - 28, drawn to method for determining the especially three-dimensional, conductivity distribution, in an examination area.

Group III, claim(s) 29 – 32, drawn to use of apparatus for examination and use of an electrical field in a magnetic gradient field, containing magnetic particles in examination area.

Group IV, claim(s) 17 and 18, drawn to method for, especially locally targeted, drug release in an examination area.

Group V, claim(s) 19 - 21, drawn to method for electro-stimulation.

Group VI, claim(s) 33 - 43, drawn to use of electro-physiological contrast composition for magnetic particle imaging.

Group VII, claim(s) 44, drawn to method for imaging internal electric fields in a living organism.

Group VIII, claim(s) 45, drawn to process for manufacture of electro-physiologic contrast composition as claimed in Claim 33.

Group IX, claim(s) 46, drawn to process for manufacture of an electro-physiologic contrast composition as claimed in Claim 13.

Group X, claim(s) 47, drawn to method for imaging electrical resistivity or conductivity in an examination area.

Group XI, claim(s) 48, drawn to method for imaging internal electrical fields.

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Group XII, claim(s) 49 - 51, drawn to magnetic particle composition having magnetization curve having step change; and use thereof.

2. The inventions listed as Groups I – XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I, and Groups II, X, and XI do not meet the unity of invention requirement because the method of Group II can use a materially different apparatus that does not require the second arrangement of Group I; and groups X and XI can use a materially different apparatus that does not require the first arrangement of Group I.

Group I, and Groups III, IV, V, VI, VII, VIII, IX, X, XII does not meet the unity of invention requirement because the featured uses of Group III can be practiced by a materially different apparatus with a different “second arrangement” than the apparatus of Group I; Group IV is drawn to an unrelated method; groups V and VII can be performed by a materially different apparatus that does not require the first arrangement of Group I; Group VI is drawn to the use of an unrelated apparatus; groups VIII and IX are drawn to unrelated processes; Group X can be practiced by a materially different apparatus that does not require the use of the first arrangement of the apparatus of Group I; and Group XII drawn to a composition that does not require the second arrangement if the apparatus of Group II for utilization.

Group II, and Groups III, IV, V, VI, VII, VIII, IX, X, XI, and XII do not meet the unity of invention requirement because the uses as listed in Group III are can be performed by a variety of methods comprising steps different than the steps of the method of Group II; groups III, IV, and V are drawn to unrelated methods; Group VI is drawn to the use of a composition that is not required while performing the method of Group II; groups VII, X, and XII are drawn to a method that requires performing steps that do not overlap with the steps of Group II; groups VIII and IX are drawn to the process of manufacturing contrast compositions and are unrelated to the method of Group II; and Group XII can be used following an entirely different set of steps than the one of the method of Group II.

Group III, and Groups IV, V, VII, X and XI do not meet the unity of invention requirement because Group III is drawn to a use of an apparatus, and is unrelated to the method(s) of each the other groups.

Group III, and Groups VIII and IX do not meet the unity of invention requirement because Group III is drawn to a use of an apparatus that is unrelated to the process of manufacturing an electro-physiologic contrast of Group VIII; and to that of the process of manufacturing electro-physiologic contrast of Group IX.

Group IV, and Groups V, VII, X, and XI do not meet the unity of invention requirement because Group IV is drawn to a method that comprises steps that do not meet the steps of the methods of the other groups.

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Group IV and Group VI do not meet the unity of invention requirement because the two groups are drawn to unrelated method locally targeted drug release and use of electro-physiologic contrast.

Group IV and Groups VIII and IX do not meet the unity of invention requirement because groups VIII and IX are drawn to processes for manufacture of electro-physiologic contrast, which is unrelated to the method of Group IV.

Group V and Group VI do not meet the unity of invention requirement because Group V is drawn to a method that is unrelated to the use of electro-physiologic contrast of Group VI.

Group V and Groups VII, X, XI, VIII and IX do not meet the unity of invention requirement because Group V is drawn to a method of electro-stimulation that is unrelated to the methods of the other three groups VII, X, and XI; to the processes for manufacture of electro-physiologic contrast of groups VIII and IX, and to the magnetic particle composition of Group XII.

Groups VI and Groups VII, VIII, IX, X, XI, XII do not meet the unity of invention requirement because Group VI is drawn to a use of an electro-physiologic contrast composition that is unrelated to the method of Group VII, to the process of Group VIII, to the process of Group IX, to the method of Group X, and to the method XI, and to the magnetic particle composition of Group XII.

Groups VII and Groups VIII, IX, X, XI, and XII do not meet the unity of invention requirement because Group VII is drawn to a method that is unrelated to the processes of groups VII and VIII; because groups X and XI are drawn to methods that comprises steps that do not overlap with the steps of the method of Group VII; and because XII is drawn to the magnetic particle composition that is not required to perform the steps of Group VII.

Groups VIII and Groups IX, X, XI, and XII do not meet the unity of invention requirement because Group VIII is drawn to a process for manufacturing electro-physiologic contrast composition which comprises steps that do not overlap with the process of manufacturing electro-physiologic contrast of Group IX; because X and XI are drawn to unrelated methods; methods that comprises steps that do not overlap with the steps of the method of Group VII; and because XII is drawn to the magnetic particle composition that is materially different than the composition of Group VIII.

Group IX, and Groups X, XI, and XII do not meet the unity of invention requirement because Group IX is drawn to a process of manufacturing of an electro-physiologic contrast composition, which is unrelated to the methods of groups X and XI; and Group XII is drawn to a composition that is materially different than the composition of Group IX.

Group X, Groups XI and XII do not meet the unity of invention because Group X is drawn to a method of imaging electrical resistivity or conductivity in an examination area, which comprises

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steps that do not overlap with the steps of Group XI which is drawn to the method of imaging internal electrical fields of Group XI; and because Group XII is drawn to a composition that is not required while performing the steps of the method of Group X.

Group XI and Group XII do not meet unity of invention because they are drawn to unrelated method and composition.

3. A telephone call was made to David Barnes on March 30, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined

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claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANI GUPTA whose telephone number is (571)270-5042. The examiner can normally be reached on Monday - Friday (8:30 am - 5:30 pm; EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-2083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. G./

Examiner, Art Unit 3768

/Long V Le/

Supervisory Patent Examiner, Art Unit 3768